

REMARKS

In the Official Action, the Examiner raised a single rejection under the first paragraph of 35 U.S.C. §112. In particular, the Examiner stated that the identity of the "polyolefin copolymer resin emulsion" could not be determined and mentioned that the only specific material disclosed was "Chemipearl".

By the present Amendment, minor revisions have been made in the specification. With regard to the sole rejection set forth in the Action, applicants initially note that the use of "Chemipearl" in the Examples is not the only discussion of the polyolefin copolymer resin emulsion which constitutes component (c) of the defined thermal recording material of claim 1. The polyolefin copolymer resin emulsion is discussed in the passage beginning at page 9, line 22 and the specific characteristics of the resin emulsion and the function thereof are explained. However, to show that the polyolefin copolymer resin emulsion in general and "Chemipearl" in particular are well known in the art, applicants are hereby providing a catalog relating "ChemipearlTM" that specifically identifies W4005 (which is identified in Example 1 on page 21 and in the Table on page 28 of the specification). For the Examiner's convenience, an English translation of this document is also provided.

The translation of the catalog provides further insight into the characteristics of the Chemipearl material which must be considered to be known to those of ordinary skill in the art at the time the present application was filed.

To provide still further insight into the understanding of the polyolefin copolymer resin emulsion, the Examiner's attention is respectfully directed to the attached copy of U.S. Patent No. 4,174,335 and JP-A-52-29844(1977). For the Examiner's further convenience, an English translation of the '844 Japanese

publication is further provided. These patent documents describe the resin emulsion and how it can be prepared.

The information which is provided herewith makes it clear that at the time the application was filed, those of ordinary skill in the art had a full comprehension of polyolefin copolymer resin emulsions, particularly in view of the noted discussion on pages 9 and 10 of the specification and the specific materials described in the Examples. Accordingly, applicants respectfully submit that the specification would enable those of ordinary skill in the art to make and use the presently claimed invention without undue experimentation. In this respect, it is noted that the Federal Circuit has stated in *Engel Industries, Inc. v. Lockformer Co.*, 20 USPQ2d 1300, 1304 (Fed. Cir. 1991): "the enablement requirement is met if the description enables any mode of making and using the claimed invention." The Federal Circuit has further made it clear that the specification does not have to set forth information which is known in the art. This understanding has been set forth in decisions such as *Spectra-Physics, Inc. v. Coherent, Inc.*, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), *cert denied*, 484 U.S. 954 (1987) wherein the Court stated: "A patent need not teach, and preferably omits, what is well known in the art."


Since polyolefin copolymer resin emulsions were well known in the art at the time the application was filed, as can be understood by the technical information provided herewith, applicants respectfully submit that the enablement requirement of the first paragraph of 35 U.S.C. §112 has been fully met. Accordingly, since the only rejection set forth in the Action has been fully met, reconsideration and allowance of the present application are respectfully requested.

As additional matters, applicants respectfully refer to the fact that the present application is the national stage of an international application in which the certified copy of the priority document has been submitted as noted by Form PCT/IB/304 (provided with the present application at the time of filing) and the Notice of Acceptance dated August 30, 2005. Therefore, applicants respectfully request acknowledgement of receipt of the priority document in the next Official Action. In addition, applicants note that a Second Information Disclosure Statement was filed on August 8, 2006 and applicants also request that the Examiner consider this information and return the acknowledged citation form with the next Action.

Should the Examiner wish to discuss any aspect of the present application, he is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

By: 
Robert G. Mukai
Registration No. 28531

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620

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